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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,702	10/06/1999	DOMINIQUE CAZIN	511/96506.01	6300

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/402,702

Applicant(s)

CAZIN, DOMINIQUE

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

## DETAILED ACTION

1.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okutomi et al (US Patent No. 6,211,972).

Concerning claim 1, Okutomi et al discloses a facsimile machine (FAX connected to PSTN, Fig.2) designed to be connected to a telephone network (PSTN) and to communicate with corresponding facsimile machines (FAX connected to telephone line L1) across a computer network of the Internet type (LAN, Internet), the fax machines, each having an electronic address on the aforesaid computer network, characterized by the fact that it has memory means (Table in Fig.6) for storing a record of the fax machine, containing the electronic addresses of the aforesaid corresponding fax machines, means for managing the record (1), for extracting the electronic addresses and associating them with the corresponding fax machines, and means for extracting a corresponding fax machine for its electronic address, the managing means 1 enters the electronic address of the corresponding fax machine into the table (Figs. 23, 5, 6,7, 8, 9 12, 13; Abstract; col. 3, line 12 – col. 4, line 61; col. 5, line 32 – col. 6, line 41).

Okutomi et al does not specifically teaches means for asking a corresponding fax machine for its electronic address during a communication with the corresponding fax machine across the telephone network. However, Okutomi teaches that telephone number of the facsimile machine and its corresponding e-mail address are entered and received during a communication with the fax machines across the telephone network (PSTN). Okutomi further teaches that the LAN controlling section 7 receives an e-mail containing the data of the correspondence table of e-mail addresses and telephone numbers (Fig.6) and takes out the data part from the e-mail, recognizes the data of correspondence table from the data part of the e-mail and stores the data of correspondence table in the HD 9. Thus, Okutomi teaches the reception and storing of the correspondence table of telephone numbers and e-mail address according to the correspondence table (col. 3, line 12 – col. 4, line 61; col. 5, line 32 – col. 6, line 41). In addition, in the Background of the Invention, Okutomi teaches the well known prior art of the conventional facsimile system wherein an operator enters a mail broadcast command, a mail address and a broadcast address through an operation panel of the facsimile machine 100. This causes the facsimile 100 to direct the host computer 200 to transmit an e-mail to the instructed e-mail address (col. 1, lines 24-35). It would have been obvious to one skilled in the art to consider the Okutomi teaches means for asking a corresponding fax machine for its electronic address during a communication with other fax machines across the telephone network since Okutomi teaches an operation panel in fax 6 or panel controlling section 12 (Fig.7) wherein an operator enters the telephone number or e-mail address of the receiving facsimile machine or host computer.

Concerning claims 2-7, Okutomi further teaches an electronic mail converter apparatus for facsimile machine (Fig.2 or 3) for receiving a fax transmitted from a corresponding fax

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machine and associated with the electronic address on the computer network. Okutomi further teaches means for managing the record (1, Fig.3) extract the identification data from each address of a corresponding fax machine and to associate the data with the aforesaid address in the record (table); compares the identification data extracted from each new electronic address with the identification data associated with the electronic addresses stored in the record; stores or replace the new e-mail address, to erase the oldest electronic address in the table prior to entering a new electronic address (col. 3, line 12 – col. 4, line 61; col. 5, line 32 – col. 6, line 41).

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Oseto (US Patent No. 6,097,797) discloses a network facsimile apparatus capable of e-mail communications.
- b. Wong (US Patent No. 6,185,288) teaches a multimedia call signaling system for performing call signaling for multimedia call setups.
- c. Rachelson (US Patent No. 6,157,706) recites a method and apparatus for enabling a facsimile machine to be an e-mail client.

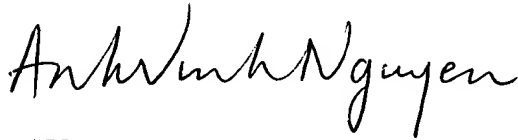
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



AV  
May 20, 2002

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622